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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,892	06/28/2006	Peter Bleckert	P18823-US1	1926
27045 ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024	7590 06/01/2009		<div>EXAMINER</div> <div>HOQUE, NAFIZ E</div>	
			<div>ART UNIT</div> <div>2614</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE</div> <div>06/01/2009</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/596,892	BLECKERT ET AL.	
	Examiner	Art Unit	
	NAFIZ E. HOQUE	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 21-24, 26-29 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 21-24, 26-29 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to 35 USC § 102 rejection of claims 18, 22-23, 27-28, and 31-34 have been considered but are moot in view of the new ground(s) of rejection.

But with regards to 35 USC § 103 rejection, Applicant argues that "Sylvain fails to cure the deficiencies of Jennings" and "Sylvain only discloses how a telephony device can be associated with a multimedia client, enabling a voice call to be routed through the packet network via the multimedia client".

In response, Examiner respectfully disagrees. Sylvain discloses a SIP server 26 used for receiving, analyzing and responding steps are performed for shared multimedia capabilities (Para 006; 0023-026; 0029-0032).

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In conclusion, the rejection is maintained.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-19, 21-24, 26-29 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al. (US 6,430,174) in view of Sylvain (US 2004/0120498).

Regarding claims 18,21, 23, 26 and 28-29, Jennings teaches a method for automatically discovering a shared multimedia service capability of two user equipments when initiating a voice call between two parties, one of the user's equipment, which belongs to a calling party being capable of running simultaneously both a circuit switched voice call in a CS network, and a packet switched IP session supported by a PS network, and at least one second user equipment, belonging to a called party, which multimedia capability may be unknown to the calling party and for discovering matching multimedia capability of the two user equipments when initiating a voice call over the circuit switched network to the other user equipment (Abstract; Fig. 1, 2a, 2b; col. 3, lines 3-29), the method comprising the steps of:

receiving from means in the CS network simultaneously a capability request for the two user equipments to the PS network supporting the SMM service (col. 5, lines 25-35);

analyzing the capability request by means in the PS network; and responding simultaneously to the user equipments information regarding matching multimedia capability, if at least one matching service is found (col. 6, lines 27-32).

Jennings does not disclose that the receiving, analyzing and responding steps are performed by a SIP Application Server for Shared Multimedia Services and that a response is sent to both user equipments as a SIP message.

Sylvain discloses that the receiving, analyzing and responding steps are performed by a SIP Application Server for Shared Multimedia Services (Fig. 1, element 26; Para 006; 0023-026; 0029-0032) and that a response is sent to both user equipments as a SIP message (Para 0023).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Jennings with teaching of Sylvain, to use SIP to provide signaling and session management for voice and multimedia connections over packet-based networks.

Regarding claims 22, 27, and 31, Jennings teaches wherein the generation of capability requests by the means in the CS network is based on IN technology or Parlay technology (fig. 1, element 100 - IN network which has decision making capabilities).

Regarding claims 19 and 24, Sylvain teaches the step of registering the supported SMM Capabilities of the user equipment SMM Capabilities in a SIP registration procedure towards an IMS element of the user equipment's home PS network at user equipment power on (Para 0049).

Regarding claims 32-34, Jennings teaches a computer program product comprising computer executable software stored on a computer readable medium, the software being adapted to run on a computer or other processing means (col. 10, line 64 - col. 11, line 10).

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAFIZ E. HOQUE whose telephone number is (571)270-1811. The examiner can normally be reached on M-F Alternate Fridays Off 7:30 - 5:00 PM EST.

Art Unit: 2614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on 571-272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NAFIZ E HOQUE/  
Examiner, Art Unit 2614

/Ahmad F Matar/  
Supervisory Patent Examiner, Art Unit 2614